

REMARKS

Claims 56-75 are in the application. Claims 56 and 71 are independent.

Claim 56 has been amended to clarify the subject matter thereof. Dependent claims 63 and 64 have been amended to make minor formal changes. Claims 71-75 are new. Claims 56-70 were allowed over the prior art, the only rejections in the Office Action being for obviousness-type double patenting. In response, a terminal disclaimer with respect to U.S. Patent No. 6,322,773 and U.S. Patent No. 6,536,628 is enclosed. The Office Action indicated that the various double patenting rejections in view of those patents would be avoided by a terminal disclaimer.

A check in the amount of \$110 is enclosed to cover the fee under 37 C.F.R. § 1.20(d) for the submission of a terminal disclaimer. Any other fees attributable to this submission may be charged to Deposit Account No. 50-0409.

The clarifying changes to claim 56 are not believed to affect its allowance over the prior art. For the most part, the changes simply reword the claim language in a form the applicant believes is somewhat clearer. The only new element introduced into claim 56 is the substitution of a “static mixer” for the previously recited “mixing baffle.” Support for the recitation of a static mixer for mixing together two components expelled from a multi-chambered vessel to form a single composition is found in the specification at page 7, lines 21-25.

Accordingly, the applicant believes that claims 56-75 are allowable.

New independent claim 71 adopts the general format of allowable claim 56, but more specifically recites a vessel with two chambers, each containing a gel having a composition supported by Example 2 discussed at pages 10-11 of the specification. Dependent claims 72-74 recite even more specifically the compositions of the gels, again based on Example 2 in the specification. The Markush groups of new claim 75 are taken from existing claims 63 and 64.

Accordingly, the applicant believes that claim 71 and its dependent claims 72-75 are allowable over the prior art for the same reasons as claims 56-70.

INFORMATION DISCLOSURE STATEMENT

The Examiner is requested to consider the enclosed documents and return a copy of the enclosed Form PTO-1449 with each entry initialed to confirm that it has been considered in connection with the patentability of claims 56-75. Copies of various listed documents are enclosed, as discussed below. Also enclosed is a chart that illustrates the relationship of all of the patent family members, including the present application, tracing their lineage to U.S. Patent No. 5,922,307.

The documents listed on the enclosed Form PTO-1449 are from a number of sources. First, they include all of the references of record from parent U.S. Patents No. 5,922,307 and No. 6,312,670. Since the present application relies on the applications from which those patents issued for an earlier effective filing date under 35 U.S.C. § 120, copies of the listed documents of record from those patents are not enclosed. See 37 C.F.R. § 1.98(d). However, the applicant will provide copies of all of those references if the Examiner so requests.

Second, the listed documents include WO 97/11676, the published PCT application corresponding to the present application's original parent, now U.S. Patent No. 5,922,307, and the International Preliminary Examination Report and Written Opinion in the PCT application. EP 862,408 B1, the counterpart published European version of the original parent application, is also listed. In addition, EP 1,314,419 A2 and EP 1,314,419 A3, published versions of a divisional of the original European application, are listed. All of the references cited in the various search reports and official actions included with those listed documents are themselves listed on the enclosed Form PTO-1449. Copies of these listed documents are also enclosed, except for the references of record from parent U.S. Patents No. 5,922,307 and No. 6,312,670.

Third, the listed documents include various discovery materials from litigation involving, *inter alia*, family-member U.S. Patents No. 6,514,543 and No. 6,536,628. This litigation is pending in the U.S. District Court for the Northern District of California as Case No. C02-03220 JSW, and is styled "BriteSmile, Inc., et al. v. Discus Dental, Inc., et al." Claim 14 of family-member U.S. Patent No. 6,331,914 was also asserted in that litigation. The documents from that litigation listed on the Form PTO-1449 include:

1. Defendant Discus Dental, Inc.'s Preliminary Invalidity Contentions, and Exhibits D and E thereto, purporting to apply numerous references against the claims of family member U.S. Patents No. 6,514,543 and No. 6,536,628.
2. Production of Documents Accompanying Defendant Discus Dental, Inc.'s Preliminary Invalidity Contentions (Exhibits D to O and Q to V therefrom, comprising the references applied in the Preliminary Invalidity Contentions, no. 1 above, are listed on the enclosed Form PTO-1449. U.S. Patent No. 5,922,307, also applied in the Preliminary Invalidity Contentions, is already of record.).
3. Transcript of deposition of Robert E. Montgomery (the inventor of the present application) taken on August 29, 2003, and Exhibits 517 and 519 to 521 thereto. Exhibits 514 to 516 are already of record. (Exhibit 518 is the provisional application on which the present patent family claims priority.) The Examiner should, of course, read the entire deposition transcript, but the applicant believes that pages 13-15, which discuss a two-component tooth bleaching system using a static mixer (a definition of which is contained at page 14, line 18, to page 16, line 6), pages 15-23, which discuss Exhibit 517, and pages 58-69, which discuss Example 2 of the present application, contain the testimony most relevant to the present application. (Some of

the enclosed deposition transcript has been redacted in accordance with a protective order in the litigation.)

4. The deposition of John F. Witherspoon taken on March 8, 2004. The Examiner should, of course, read the entire deposition transcript, but the applicant believes that pages 48-50 and 64-79, relating to the prosecution of family-member U.S. Patent No. 6,488,914, contain the testimony most relevant to the present application.
5. Plaintiff's Preliminary Claim Constructions and Extrinsic Evidence. The Examiner will, of course, read this entire document, but she may find of interest pages 12-13, relating to the claim terms "mixer" and "mixture" in family-member U.S. Patents No. 6,514,543 and No. 6,536, 628.
6. Plaintiffs' Opening Claim Construction Brief. Again, the Examiner will, of course, read this document in its entirety, but she may find of interest footnote 4 on page 2, relating to the claim "static mixer" in family-member U.S. Patents No. 6,514,543 and No. 6,536, 628. For completeness, the responsive Discus Dental, Inc.'s Memorandum of Points and Authorities in Support of Its Proposed Claim Constructions and Response to BriteSmile's Opening Claim Construction Brief, and BriteSmile's Reply in Support of Its Proposed Claim Construction, are also listed.
7. Dr. Nathoo and OHCS' Amended Answer to Plaintiffs' Third Amended Complaint and Amended Counterclaims, and Exhibits A to P thereto. Paragraphs 110-203 contain allegations that the named inventorship on patents and applications in the family comprising the present application is incorrect. Paragraph 142 relates specifically to the present application, alleging that its inventorship is incorrect.

If the Examiner would like copies of any other materials from the Discus Dental litigation, the applicant will endeavor to provide them. That is, the applicant has made every

effort to provide the Examiner with all relevant materials, without overburdening the record with an undue amount of information. However, if any of the materials provided by the applicant refers to other materials that the Examiner would like to review, the applicant will make every effort to provide the Examiner with any information she believes could be relevant to her examination of the present application.

There is another litigation involving patents in this family, namely U.S. Patents No. 5,922,307, No. 6,331,292 and No. 6,488,914. That litigation is pending in the U.S. District Court for the Southern District of Ohio as Case No. C-1-03-433, and is styled "The Procter & Gamble Co. v. Oraceutical LLC, et al." The applicant does not consider any of the documents in that litigation material to the examination of the pending claims in the present application. However, the Procter & Gamble (the declaratory judgment plaintiff) has alleged that the patents in suit are invalid and unenforceable on several grounds, as noted in the Defendants' Answer and Counterclaims, listed on the enclosed Form PTO-1449. A copy of that paper is also enclosed, and the applicant will endeavor to answer any questions the Examiner may have about that litigation after considering that paper.

SUMMARY

The applicant believes that this Amendment, Submission of Terminal Disclaimer, and Information Disclosure Statement responds to all of the points raised in the Office Action, and respectfully requests allowance of the present application, with claims 56-75.

Any fees due on account of this paper should be charged to Deposit Account No. 50-0409.

If the Examiner has any questions regarding this application, she is requested to telephone the applicant's undersigned attorney.

Respectfully submitted,



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